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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,076	02/09/2001	Omar M. Buazza	5040-04203	7773

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EXAMINER	
HECKENBERG JR, DONALD H	
ART UNIT	PAPER NUMBER
1722	7

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Please find below and/or attached an Office communication concerning this application or proceeding.

mk-7

Office Action Summary	Application No.	Applicant(s)	
	09/780,076	BUAZZA ET AL.	
	Examiner	Art Unit	
	Donald Heckenberg	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *346-399* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *346-399* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5, 6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. Claim 388 is objected to because of the following informalities: Claim 388 refers to the "control unit" in line 2. It is believed that this is intended to refer to the "controller" defined previously in the claims. However, for clarity the same language should be used throughout the claims.

Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 395 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 395 recites "monomer type" and "lens type[.]" The addition of the word "type" to an otherwise definite expression

extends the scope of the expression so as to render it indefinite. Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955). See also MPEP § 2173.05(b).

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (Cust. & Pat. App. 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (Cust. & Pat. App. 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (Cust. & Pat. App. 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 366 and 383-399 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 293-310 of copending Application No. 09/780,215 (hereinafter "App. '215") in view of Kachel et al. (US Pat. No. 4,895,102; previously of record).

Claim 366 of the instant application recites all of the limitations of claim 293 of App. '215. Additionally claim 366 of the instant application recites a coating unit for applying a coating to the eyeglass lens during use. Claims 383-399 of the instant application are identical to claims 294-310 of App. '215.

Kachel teaches a lens forming apparatus in combination with a coating unit which applies abrasion resistant coatings to the formed eyeglass lenses (see col. 8, ln. 38 - col. 10, ln. 34).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus recited in claim 366 of the instant application as such to have added a coating unit because this would have allowed for coatings to be applied to the molded eyeglass lenses and therefore make the lenses more abrasion resistant as suggested by Kachel. Therefore, claim 366 of the instant application is obvious in view of claim 293 of App. '215.

This is a provisional obviousness-type double patenting rejection.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 346-365 are rejected under 35 U.S.C. 102(e) as being anticipated by Powers et al. (US Pat. No. 6,228,289).

Powers teaches an apparatus for preparing an eyeglass lens comprising a first mold member having a casting face and a non-casting face, a second mold member having a casting face and a non-casting face, the second mold member being spaced apart from the first mold member during use such that the casting faces of the first mold member and the second mold member at least partially define a mold cavity (fig. 11), a lens curing unit (30 and 40) configured to direct activating light and heat toward

the mold members during use, and a spin-coating unit (20) for applying a coating to an eyeglass lens.

Powers further teaches the apparatus to be configured to form photochromic and non-photochromic lenses (col. 2, lns. 52-54), and bifocal lenses (col. 37, lns. 48-51). Powers also teaches the coating unit to comprise a holder (108) for holding and revolving a mold or lens during use, and the coating unit having a cover (22) with an ultraviolet activating light source configured to direct light towards the coating unit during use (col. 10, lns. 30-63).

Powers also teaches the lens curing unit to comprise first and second light sources (214 and 218), filters disposed between the light source and the mold member (col. 3, lns. 7-63), a lens drawer (216) for positioning the mold members within the lens curing unit during use, and a controller (50) to control operation of the lens curing unit and coating unit during operation of the apparatus.

It is noted that although the reference of Powers et al. has common inventors with that of the instant application, there is at least one different inventor, and thus the application contains a different inventive entity, and therefore qualifies as prior art under 35 U.S.C. 102(e). See MPEP § 706.02.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that

was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 346-365 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kachel modified by Blum et al. (US Pat. No. 4,919,850; previously of record).

Kachel teaches an apparatus for making eyeglass lenses comprising a first mold member having a casting face and a non-casting face (fig. 11), a second mold member having a casting face and a non-casting face (fig. 11), the second mold member being spaced apart from the first mold member during use such that the casting faces of the first mold member and the second mold member at least partially define a molding cavity (120), a spin coating unit for applying a coating to the eyeglass lens (see col. 8, ln. 38 - col. 10, ln. 34).

Kachel further teaches the spin coating unit to comprise a holder for securing the mold members configured to revolve during use (see col. 7, ln. 63 - col. 8, ln. 19), and the coating unit having an activating light source (10) configured to direct activating light towards the coating unit during use.

Kachel also teaches a lens curing unit comprising heating ovens to cure the lens molding material (p. 12, lns. 29-35), but fails to teach the lens curing unit to be configured to direct activating light toward the mold members during use in order to cure the lens molding material.

Blum teaches an apparatus for molding plastic eyeglass lenses which uses ultra-violet light to cure the molding material. Blum notes that UV curing is advantageous to thermal curing because UV curing is much faster (col. 1, lns. 30-55).

Blum further teaches the apparatus to comprise two sets of UV light curing sources (102 and 104) independently controlled by controller in order to tailor the resulting curing to a particular molding material (see col. 6, lns. 37-64).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Kachel as such to have also used a lens curing unit configured to direct activating ultra-violet light towards the mold members during use because this would speed up the molding process as suggested by Blum.

It also would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have two light sources independently controlled by a controller because this

would have allowed the apparatus to be configured to optimally cure particular molding materials as suggested by Blum.

13. Claims 366-386, and 388-399 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 318 164 (previously of record; hereinafter "EP '164") in view of Blum.

EP '164 teaches a lens forming apparatus comprising a front mold member (28) having a casting face, a non-casting face, and a front mold identification marking (see p. 4, lns. 35-36), a back mold member (28) having a casting face, a non-casting face and a back mold identification mark (see p. 4, lns. 35-36), the back mold member being spaced apart from the front mold member by a gasket (30) during use, the gasket comprising a gasket identification marking (see p. 4, lns. 35-36), wherein the casting faces of the front mold member and the back mold member and an inner surface of the gasket at least partially define a mold cavity (40) which defines the shape corresponding to an eyeglass prescription, a coating unit (20) for applying a coating to the eyeglass lens during use, and a controller comprising an input device for obtaining information form an user, and an output device for transmitting information to the user, wherein the controller is configured to determine the front mold identification marking, the back mold identification

marking, and the gasket identification marking in response to the eyeglass prescription being entered through the input device, and wherein the controller is configured to transmit via the output device the front mold identification marking, the back mold identification marking, and gasket identification marking, and wherein the controller is configured to control the operation of the lens curing unit during use (see p. 12, ln. 40 - p. 17, ln. 12).

EP '164 teaches the use of heating ovens to cure the lens molding material (p. 12, lns. 29-35), but fails to teach the lens curing unit to be configured to direct activating light toward the mold members during use in order to cure the lens molding material.

EP '164 also fails to teach the lens curing unit to comprise a first light source and a second light source, wherein the controller is configured to individually control the first and second light sources.

Blum teaches an apparatus for molding plastic eyeglass lenses which uses ultra-violet light to cure the molding material. Blum notes that UV curing is advantageous to thermal curing because UV curing is much faster (col. 1, lns. 30-55).

Blum further teaches the apparatus to comprise two sets of UV light curing sources (102 and 104) independently controlled

by controller in order to tailor the resulting curing to a particular molding material (see col. 6, lns. 37-64).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have used a lens curing unit configured to direct activating ultra-violet light towards the mold members during use because this would speed up the molding process as suggested by Blum.

It also would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 as such to have two light sources independently controlled by a controller because this would have allowed the apparatus to be configured to optimally cure particular molding materials as suggested by Blum.

14. Claim 387 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '164 modified by Blum as applied to claims 366-386, and 388-399 above, and further in view of Buazza et al. (US Pat. No. 6,086,799; previously of record).

EP '164 and Blum teach the apparatus as described above. EP '164 and Blum fail to teach the apparatus to further comprise a light sensor configured to measure the dose of light transmitted to the mold cavity, wherein the light sensor is configured to

communicate with the controller, and wherein the controller varies the intensity or duration of light such that a predetermined dose is transmitted to the mold cavity.

Buazza teaches a lens molding apparatus comprising a light sensor configured to measure the dose of light transmitted to the mold cavity and wherein the light sensor is configured to communicate with the controller, and wherein the controller varies the intensity or duration of light such that a predetermined dose is transmitted to the mold cavity (col 45, ln. 56 - col. 46, ln. 9).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of EP '164 and Blum as such to have lens molding apparatus further comprise a light sensor working in conjunction with a controller because this would have allowed to the lens to be optimally cured with predetermined doses of light as suggested by Buazza.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jan Silbaugh, can be reached at (703) 308-3829. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Donald Heckenberg
August 27, 2002

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8/30/02